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ART UNIT	PAPER NUMBER
3686	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/634,893	HAIL ET AL.
	Examiner	Art Unit	
	VIVEK D. KOPPIKAR	3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *18 August 2009*.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-58* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-58* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
        application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Status of the Application

1.   Claims 1-58 have been examined in this application. This communication a Final

Office Action in response to the "Amendment" and "Remarks" filed on August 18, 2009.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

3.   Claims 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over US

Patent Number 5,182,705 to Barr in further view of US Patent Number 6,810,382 to Wamsley.

(A)   As per claim 46, Barr teaches a system for managing litigation related to an

insurance claim (Barr: Abstract), comprising:

        means for receiving data about an insurance claim (Barr: Col. 1, Ln. 64-Col. 2,

Ln. 15; Col. 3, Ln. 28-43 and Claim 3);

        means for automatically assigning the insurance claim to a litigation administrator

when a litigation criteria is met by the received data (Barr: Col. 1, Ln. 64-Col. 2, Ln. 15; Col. 3,

Ln. 28-43 and Claim 3);

        means for automatically establishing a budget for the litigation administrator

based on the received data (Barr: Col. 1, Ln. 64-Col. 2, Ln. 15; Col. 3, Ln. 28-43 and Claim 3);

means for providing a user interface for an auditor to determine at least one of the assigned litigation administrator, the established budget, and a status of the litigation (Barr: Col. 1, Ln. 64-Col. 2, Ln. 15; Col. 3, Ln. 28-43 and Claim 3); and

means for automatically generating a task for the litigation administrator based on the received data (Barr: Col. 1, Ln. 64-Col. 2, Ln. 15; Col. 3, Ln. 28-43 and Claim 3).

Barr does not teach the following feature which is taught by Wamsley (Figure 2A; Col. 18, Ln. 30-45 and Col. 19, Ln. 25-43):

wherein the user interface displays a screen comprising:

a first section including description information of the insurance claim;

a second section including referral information to receive, from the litigation administrator a selection of an attorney to manage the litigation; and a third section including a list of tasks associated with the insurance claim and status completion of the tasks.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Barr with these aforementioned teachings from Wamsley with the motivation of having a means of having multiple functionalities to support litigation management.

(B)   As per claim 46, this claim is substantially similar to Claim 45 and is therefore rejection in the same manner as Claim 45, which is set forth above. The only different between Claim 45 and Claim 46 is that Claim 46 is directed towards a computer-usable medium having computer readable code embodied therein for managing litigation related to an insurance claim, and Barr teaches this feature (Barr: Col. 2, Ln. 3-15).

4.   Claims 47-58 are rejected under 35 U.S.C. 102(e) as being anticipated by US
Patent Number 6,950,805 to Kavanaugh in view of US Patent Number 7,343,308 to Rojewski.

(A)   As per claim 47, Kavanaugh (Col. 3, Ln. 1-22 and Col. 4, Ln. 29-65) teaches a
method of managing fees for the recovery of costs related to insurance claims (Kavanaugh:
Abstract), comprising:

storing an agreement between a collector and a client in a database, wherein the
client has paid costs corresponding to an insurance claim;

receiving data about a recovery related to the costs corresponding to the insurance
claim, the data including at least an amount recovered;

determining taxes due on the amount recovered; and calculating a fee due to the
collector based on at least one of the amount recovered and a fee schedule specified in the
agreement.

Kavanaugh does not teach the following features which are taught by Rojewski (Col. 1,
Ln. 43-57 and Col. 2, Ln. 33-49):

paying costs to an insured in response to an insurance claim filed by the insured,
wherein the costs are paid by an insurance company and determining a party responsible for the
costs, wherein the party is different from the insurance company.

At the time of the invention, it would have been obvious for one of ordinary skill in the
art to have modified Kavanaugh with these aforementioned teachings from Rojewski with the
motivation of having a means of subrogating an insurance claim.

(B)   As per claim 48, Kavanaugh teaches the step of automatically sending the

recovered amount, less the taxes and the calculated fee, to the client (Kavanaugh: Col. 3, Ln. 1-

22 and Col. 4, Ln. 29-65).

(C)   As per claim 49, Kavanaugh teaches that the determining further includes:

           determining a jurisdiction corresponding to the insurance claim; and

           automatically retrieving a tax calculation template for the jurisdiction from a

database (Col. 3, Ln. 1-22 and Col. 4, Ln. 29-65).

(D)   As per claim 50, Kavanaugh teaches that a plurality of agreements in the database

correspond to the insurance claim, further comprising:

           retrieving a precedence rule corresponding to the insurance claim from a

database; and

           automatically selecting among the plurality of agreements using the precedence

rule (Kavanaugh: Col. 3, Ln. 1-22 and Col. 4, Ln. 29-65).

(E)   As per claim 51, Kavanaugh teaches a step of calculating the fee using a fee

schedule from a selected one of the plurality of agreements (Kavanaugh: Col. 3, Ln. 1-22 and

Col. 4, Ln. 29-65).

(F)   As per claims 52-58, these claims are substantially similar to Claims 47-51 and

are therefore rejected in the same manner as these claims which is set forth above. The only

difference is that claims 52-58 are directed towards a system and a computer-usable medium

while Claims 47-51 are directed towards a method, however, Kavanaugh teaches a system and a

computer-usable medium (Kavanaugh: Figures 9 and 10 and Col. 3, Ln. 1-22 and Col. 4, Ln. 29-

65).

5.   Claims 1-2, 6, 8-9, 13 and 16 are rejected under 35 U.S. C. 103(a) as being

unpatentable over 6,336,096 to Jernberg in view of US Patent Number 5,550,734 to Tarter and in

even further view of US Patent Number 7,343,308 to Rojewski.

(A)   As per claim 1, Jernberg teaches a computer-implemented method for managing

insurance claims (Jernberg: Abstract), comprising:

receiving data related to an insurance claim via a network (Jernberg: Col. 3, Ln. 5-40);

determining whether the insurance claim has recovery potential based on the received

data (Jernberg: Col. 3, Ln 32-40); and

establishing a payment decision for the insurance claim based on at least one of the

received data and the evaluation of the characteristic (Jernberg: Col. 3, Ln. 29-36).

Jernberg does not teach the following feature which is taught by Tarter (Detailed

Description, Paragraph 66):

if it is determined that the insurance claim has recovery potential, providing a

characteristic of the insurance claim and automatically evaluating the characteristic of the

insurance claim.

At the time of the invention, it would have been obvious for one of ordinary skill in the

art to have modified the method of Jernberg with the aforementioned teachings from Tarter with

the motivation of having a means of continuing to process insurance claims that were neither

rejected nor approved, as recited in Tarter (Detailed Description: Paragraph 66).

Jernberg in view of Tarter do not teach the following which is taught by Rojewski (Col.

1, Ln. 43-57 and Col. 2, Ln. 33-49):

to compare a value of the insurance claim with a threshold amount, wherein the insurance claim is determined to have a recovery potential when the value is greater than the threshold amount.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified Jernberg in view of Tarter with these aforementioned teachings from Rojewski with the motivation of having a means of subrogating an insurance claim.

(B)   As per claim 2, in Jernberg the data related to the insurance claim includes at least one of a treatment code, a provider and a claim value (Jernberg: Col. 3, Ln. 5-40).

(C)   As per claim 6, in Jernberg there is a step of comparing a value of the insurance claim to a threshold amount; and if the value of the insurance claim is below the threshold amount, the payment decision is to pay the insurance claim (Jernberg: Col. 3, Ln. 5-40).

(D)   As per claims 8-9 and 13, these claims are substantially similar to Claims 1-2 and 6, respectively, and are therefore rejected in the same manner as these claims, which is set forth above. The only difference between claims 8-9 and claims 1-2 is that claims 8-9 are directed towards system claims, however, Jernberg teaches a system (Jernberg: Col. 3, Ln. 5-40).

(E)   As per claims 15-16, these claims are substantially similar to Claim 1 and are therefore rejected in the same manner as claim 1, which is set forth above. The only difference is that Claim 15 is directed towards a system while Claim 16 is directed towards a computer-usable medium while claim 1 is directed toward a method. However, Jernberg teaches a system and a computer-usable method (Jernberg: Col. 3, Ln. 5-40).

6.   Claims 3-5 and 10-12 are rejected over 35 U.S.C.103(a) as being unpatentable over Jernberg in view of Tarter in view of Rojewski, as applied to Claims 1 and 8, above,

respectively, and in even further view of "IRT Business This Week 2 (Fraud): Some insurance firms have paid bounties to beat fraud-Insurers say fraudulent claims cost them (pounds) 30 million last year" (hereinafter referred to as IRT).

(A)　　　As per claims 3-5 and 10-12, the combined teachings of Jernberg in view of Tarter do not teach the following features which are taught by IRT (Page 1, Lines 20-27):

determining whether a related insurance claim has been received; determining whether a worker's compensation claim corresponding to the insurance claim has been accepted and determining whether first party insurance coverage corresponding to the insurance claim is available (IRT: Page 1, Lines 20-27).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Jernberg in view of Tarter in view of Rojewski with these aforementioned teachings from IRT with the motivation of having a means of detecting fraudulent claims, as recited in IRT (Page 1, Lines 20-27).

7.　　　Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jernberg in view of Tarter in view of Rojewski, as applied to Claims 1 and 8, above, respectively, and in even further view of US Patent Number 5,594,639 to Iliff.

(A)　　　As per claims 7 and 14, the combined teachings of Jernberg in view of Tarter do not teach or suggest the following steps which are taught by Iliff(Col. 62, Ln. 9-21):

adding the weighted values to obtain a result;

comparing the result to a likely recovery value; and

determining that the insurance claim has recover potential when the result is above the likely recovery value.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Jernberg in view of Tarter in view of Rojewski with these aforementioned teachings from Iliff with the motivation of having a means of weighing factors (i.e. various types of data) depending upon how important they are to the final result (i.e. whether a claim has recovery potential), as recited in Iliff (Col. 62, Ln. 9-21).

8.   Claims 17-30 are rejected under 35 U.S.C.103(a) as being unpatentable over US Patent Number 6,336,096 Jernberg in view of US Patent Number 5,583,758 to McIlroy and in even further view of US Patent Number 5,666,492 to Rhodes.

(A)   As per claim 17, Jernberg teaches a method for auditing insurance claims (Jernberg: Abstract), comprising:

selecting an insurance claims for audit, the insurance claim including a provider treatment code (Jernberg: Col. 3, Ln. 5-40);

assigning an auditor to audit the insurance claim (Jernberg: Col. 3, Ln. 5-40);

automatically prompting the auditor to collect data related to the insurance claim (Jernberg: Col. 3, Ln. 5-40);

receiving the collected data from the auditor (Jernberg: Col. 3, Ln. 5-40).

Jernberg does not teach the following features which are taught in McIlroy (Abstract; Col. 3, Ln. 10-26 and Col. 12, Ln. 25-35):

enabling the auditor to select among a plurality of guidelines for determining a proposed treatment code;

determining the proposed treatment code based on the collected data using the selected guideline; and

comparing the proposed treatment code to the provider treatment code.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified Jernberg with these above aforementioned features from McIlroy with the motivation of having an enhanced means of managing health care processes, as recited in McIlroy (Col. 1, Ln. 34-46).

Jernberg in view of McIlroy do not teach the following features which are taught by Rhodes (Figures 6-11 and Col. 11, Ln. 7-30) :

displaying a screen comprising:

a first section including description information of the insurance claim; and a second section including a plurality of tabs, wherein one of the tabs is a history tab which, when selected by the auditor, displays information corresponding to medical history of a patient related to the insurance claims.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Jernberg in view of McIlroy with these aforementioned teachings from Rhodes with the motivation of having a means of providing various functionalities on a user interface.

(B)   As per claim 18, the combined teachings of Jernberg in view of McIlroy in view of Rhodes teach the step of adjusting the provider treatment code based on the comparison with the proposed treatment code (McIlroy: Col. 3, Ln. 10-26). The motivation for making this modification to the teachings of Jernberg is the same as that set forth above in the rejection of Claim 17.

(C)   As per claims 19-22, the combined teachings of Jernberg in view of McIlroy in view of Rhodes teach generating a request for additional data related to the insurance claim; automatically sending the request to the provider; creating a data entry template for the auditor based on at least one of the provider treatment code and the data related to the insurance claim; comparing the provider treatment code from the insurance claim with a diagnostic code form the insurance claim and comparing a plurality of treatment codes associated with the insurance claims (McIlroy: Abstract; Col. 3, Ln. 10-26 and Col. 12, Ln. 25-35). The motivation for making these modifications to the teachings of Jernberg is the same as that set forth above in the rejection of Claim 17.

(D)   As per claims 23-30 these claims are rejected in the same manner as claims 17-22, which is set forth above. The only difference between claims 23-30 and claims 17-22 is that claims 17-22 are directed towards method claims while claims 23-30 are system claims, however, Jernberg teaches a system (Jernberg: Col. 3, Ln. 5-40).

9.   Claims 31, 32, 34-39 and 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 6,336,096 to Jernberg in view of US Patent Number 5,855,005 to Schuler in view of Wamsley.

(A)   As per claim 31, Jernberg teaches a method for managing litigation related to an insurance claim (Jernberg: Abstract), comprising:

        receiving data about an insurance claim (Jernberg: Col. 3, Ln. 5-40);

        automatically assigning the insurance claim to a litigation administrator when a litigation criteria is met by the received data (Jernberg: Col. 3, Ln. 5-40).

Jernberg does not teach the following features, however, they are taught by

Schuler (Figure 6; Col. 1, Ln. 15-45; 2, Ln. 63-67; Col. 4, Ln. 63-Col. 5, Ln. 5):

automatically establishing a budget for the litigation administrator based on the

received data; providing a user interface for an auditor to determine at least one of the assigned

litigation administrator, the established budget, and a status of the litigation; and automatically

generating a task for the litigation administrator based on the received data.

At the time of the invention, it would have been obvious for one of ordinary skill

in the art to have modified the teachings of Jernberg with these above aforementioned teachings

from Schuler with the motivation of having a means of auditing an exposure of an insured, as

recited in Schuler (Col. 5-27).

Jernberg in view of Schuler do not teach the following feature which is taught by

Wamsley (Figure 2A; Col. 18, Ln. 30-45 and Col. 19, Ln. 25-43):

wherein the user interface displays a screen comprising:

a first section including description information of the insurance claim;

a second section including referral information to receive, from the litigation

administrator a selection of an attorney to manage the litigation; and a third section including a

list of tasks associated with the insurance claim and status completion of the tasks.

At the time of the invention, it would have been obvious for one of ordinary skill in the

art to have modified the teachings of Jernberg in view of Schuler with these aforementioned

teachings from Wamsley with the motivation of having a means of having multiple

functionalities to support litigation management.

(B)   As per claims 32 and 34-37, Jernberg does not teach the following features which

are taught in Schuler (Figure 6; Col. 1, Ln. 15-45; 2, Ln. 63-67; Col. 4, Ln. 63-Col. 5, Ln. 5):

wherein the litigation administrator is an attorney; prompting the auditor to take action

when the task has not been completed by the litigation administrator; selecting the litigation

administrator based on the data about the insurance claim; wherein the data about the insurance

claim includes a jurisdiction and wherein the data about the insurance claim includes an area of

expertise.

The motivation for making these modifications to the teachings of Jernberg is the same as

that set forth above, in the rejection of Claim 31.

(C)   As per claims 38-39 and 41-44, these claims are rejected in the same manner as

claims 31-32 and 34-37, which is set forth above. The only difference between claims 31-32 and

34-37 and claims 38-39 and 41-44 is that claims 38-39 and 41-44 are directed towards method

claims while claims 38-39 and 41-44 are system claims, however, Jernberg teaches a system

(Jernberg: Col. 3, Ln. 5-40).

10.   Claims 33 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Jernberg in view of Schuler in view of Wamsley, as applied to Claims 31 and 38, above,

respectively, and in even further view of US Patent Application US 2002/0177991 to Ejerjed.

(A)   As per claims 33 and 40, the combined teachings of Jernberg in view of Schuler

do not teach the following features which are taught by Ejerjed (Sections [0011] and [0026]):

receiving a legal question from the auditor;

automatically determining a response to the legal question by querying a legal databases;

and

providing the response to the auditor.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Jernberg in view of Schuler with these aforementioned teachings from Ejerjed with the motivation of having a means of automatically answering a question posed by a user.

Response to Arguments

11.   Applicant's arguments filed on August 18, 2009, with respect to Claims 1-58, have been considered but are moot in view of the new grounds of rejection over the Wamsley, Rhodes and Rojewski patent references, as set forth above.

Conclusion

12.   Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109.

The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's

supervisor, Jerry O'Connor, can be reached at (571) 272-6787. The fax telephone numbers for

this group are either (571) 273-8300 or (703) 872-9326 (for official communications including

After Final communications labeled "Box AF").

Another resource that is available to applicants is the Patent Application Information

Retrieval (PAIR). Information regarding the status of an application can be obtained from the

(PAIR) system. Status information for published applications may be obtained from either

Private PAIR or Public PAX. Status information for unpublished applications is available

through Private PAIR only. For more information about the PAIR system, see http://pair-

direct.uspto.gov. Should you have questions on access to the Private PAIR system, please feel

free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,

/Vivek D Koppikar/

Primary Examiner, Art Unit 3686

10/19/2009